

### REMARKS

Claims 1-5 and 10-14 are rejected under 35 U.S.C. §102(b) as being anticipated by *Shiotsuki et al.* (U.S. 5,450,473). This rejection is respectfully traversed for the reasons set forth below.

Independent claims 1 and 11 include: ...the predetermined signal strength threshold value correlates to a predetermined distance between the first wireless device and the second wireless device; and the predetermined signal rate change threshold value correlates to a predetermined distance rate change between the first wireless device and the second wireless device.

The PTO provides in MPEP § 2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection the *Shiotsuki et al.* patent must contain all of the claimed elements of independent claims 1 and 11. However, the *Shiotsuki et al.* patent does not include the the predetermined signal strength threshold value correlates to a predetermined distance between the first wireless device and the second wireless device; and the predetermined signal rate change threshold value correlates to a predetermined distance rate change between the first wireless device and the second wireless device. Therefore, the rejection is unsupported by the art and should be withdrawn.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." "The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Furthermore, the reference would be defective in establishing a *prima facie* case of obviousness for the reasons stated above.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...

The Federal Circuit has held that a reference did not render the claimed combination *prima facie* obvious in *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), because inter alia, the examiner ignored a material, claimed, temperature limitation which was absent from the reference. In variant form, the Federal Circuit held in *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987), that there was want of *prima facie* obviousness in that:

The mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that [the requirement is in the reference].

In *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir 1984), the Federal Circuit reversed a district court holding of invalidity of patents and held that:

The "difference" may have seemed slight (as has often been the case with some of history's great inventions, e.g., the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

The Federal Circuit has also continually cautioned against myopic focus on the obviousness of the difference between the claimed invention and the prior art rather

than on the obviousness *vel non* of the claimed invention as a whole relative to the prior art as §103 requires. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986).

In the present case, the reference fails to teach all the limitations of the claimed invention. Thus, the rejection is improper because, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. In this context, 35 USC §103 provides that:

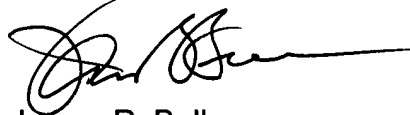
A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the *subject matter* as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Because all the limitations of independent claims 1 and 11 are not met by the *Shiotsuki et al.* patent, it is impossible to render the subject matter as a whole obvious. Thus the explicit terms of the statute could not be met to factually support any *prima facie* conclusion of obviousness.

Claims 6-9 and 15-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 6 and 15 have been cancelled, and the subject matter considered allowable by the Examiner has been added to independent claims 1 and 11. Therefore, claims 1 and 11, and the claims dependent thereon are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1-5, 7-14, and 16-18 are in condition for allowance. Accordingly, an early Notice of Allowance for remaining claims is courteously solicited.

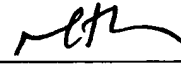
Respectfully submitted,



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